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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte EUGENE AMDUR, ANDREW FLINT, STEVEN LAMB,
STEVE KOTSOPOULOS, IRVING REID, C. HARALD KOCH,
ANDRZE SZYSZKOWSKI, and LARYN-JOE FERNANDES

Appeal 2008-0363
Application 09/611,463
Technology Center 2100

Decided: August 29, 2008

Before LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 5-11. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse, and enter new grounds of rejection as permitted by
37 C.F.R. § 41.50(b).

Appellants' invention relates to a computer security service having a policy builder to provide a graphical user interface to be used by a policy manager to define access policies for users seeking to access network services and resources. (Abstract.) Claims 5 and 11 are illustrative.

5. A computer security service for a computer network accessible by users and comprising services and resources, the computer security service comprising,

a policy builder component available to one or more policy managers, for defining access policies for the computer network users, services and resources, and

a web-based delegated administration component accessible to users for defining access policies for the computer network users, services and resources, the delegated administration component comprising a graphical user interface available to users for defining said access policies.

11. A computer program product for users with a computer network, said computer program product comprising a computer usable medium having computer readable program code means embodied in said medium for implementing the computer security service of claim 5, 6, 7, 8, 9, or 10.

The Examiner relies on the following reference as evidence of unpatentability.

Schneider	US 6,178,505 B1	Jan. 23, 2001
		(filed Mar. 4, 1998)

Claims 5-11 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Schneider.

Claims 1-4, 12, and 13 have been withdrawn from consideration as being directed to non-elected inventions.

Rejection over Schneider

The Examiner's rejection of claim 5 as being anticipated by Schneider is set forth at page 5 of the Answer. The Examiner reads both the recited "web-based delegated administration component accessible to users" and its associated function (i.e., "for defining access policies . . .") as limitations. Appellants argue, however, that Schneider does not link the indicated "component" with the claimed function.

We agree with Appellants. Schneider does not describe the web-based IntraMap interface, principally described in columns 25 and 26 of the reference,¹ as a component "for defining access policies for the computer network users, services and resources." The IntraMap interface is for showing a user the resources that are available to that user. Schneider col. 25, ll. 12-22. The user cannot define access policies using the interface. The user, at best, can send an email to an administrator requesting access to resources that are not otherwise available to the user. Schneider col. 25, ll. 48-55; col. 28, ll. 1-6.

Further, the "Policy Tables" and "FIG. 16" referenced by the Answer (at 7) are not part of the IntraMap interface. Compare Figure 16A (tables used in defining access policies; col. 31, l. 18 *et seq.*) and Figure 18 (IntraMap interface for discovering resources; col. 25, l. 12 *et seq.*).

Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as

¹ According to the reference, IntraMap is a trademark of Internet Dynamics, Incorporated.

in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

The Examiner has not shown instant claim 5 to be unpatentable over Schneider according to the precepts of anticipation. Because the same rationale is applied against claim 11, and against claims 6 through 10 which depend from claim 5, we cannot sustain the rejection of claims 5-11 under 35 U.S.C. § 102(e) as being anticipated by Schneider.

New Grounds of Rejection

I.

We reject claims 1-11 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claim 5 is drawn to a “service” not tied to a particular machine, not necessarily in computer-executable form within a machine memory, and not necessarily limited to any tangible embodiment. The abstract idea of the “service” is not limited to a practical application of the idea. As the Supreme Court has made clear, “[a]n idea of itself is not patentable.” *In re Warmerdam*, 33 F.3d 1354, 1360 (Fed. Cir. 1994) (quoting *Rubber-Tip Pencil Co. v. Howard*, 87 U.S. (20 Wall.) 498, 507, 22 L.Ed. 410 (1874)).

Claim 5 may be read, under a broad but reasonable interpretation, as reciting a collection of “components” in the abstract, such as a computer program not tied to a particular machine -- computer software *per se* or a computer listing *per se*. See *Manual of Patent Examining Procedure* § 2106.01, heading I (8th ed., Rev. 7, July 2008) (“USPTO personnel should treat a claim for a computer program, without the computer-readable

medium needed to realize the computer program’s functionality, as nonstatutory functional descriptive material.”). *Cf. AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358 (Fed. Cir. 1999) (claimed process that used “switching and recording mechanisms” to create a “signal” useful for billing purposes held statutory); *State Street Bank & Trust Co. v. Signature Fin. Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998) (“[T]he transformation of data . . . by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation.”) (emphasis added); *In re Alappat*, 33 F.3d 1526, 1544 (Fed. Cir. 1994) (“This is not a disembodied mathematical concept which may be characterized as an ‘abstract idea,’ but rather a specific machine to produce a useful, concrete, and tangible result.”) (emphasis added); *In re Cominsky*, 499 F.3d 1365, 1379 (Fed. Cir. 2007) (“When an unpatentable mental process is combined with a machine, the combination may produce patentable subject matter, as the Supreme Court’s decision in *Diehr* and our own decisions in *State Street Bank* and *AT&T* have confirmed.”).

We conclude that instant claim 5 is not limited to a statutory class (e.g., process, machine, or manufacture), and thus not directed to statutory subject matter.

We also reject claims 6 through 11, as the claims appear to add nothing to limit the subject matter to a statutory class. “The four categories [of § 101] together describe the exclusive reach of patentable subject matter. If a claim covers material not found in any of the four statutory categories, that claim falls outside the plainly expressed scope of § 101 even if the

subject matter is otherwise new and useful.” *In re Nuijten*, 500 F.3d 1346, 1354 (Fed. Cir. 2007).

II.

We reject claim 11 under 35 U.S.C. § 112, second paragraph, as being indefinite.

Instant claim 11 recites a computer usable medium having “computer readable program code means embodied in said medium for implementing the computer security service of claim 5, 6, 7, 8, 9, or 10.” Appellants’ Appeal Brief does not set forth, with reference to the Specification by page and line number, and to the drawing, if any, by reference characters, the structure corresponding to the “program code means.” *Cf.* 37 C.F.R. § 41.37(c)(1)(v).²

We, likewise, are unable to ascertain such a corresponding structure. Lack of any structure in the disclosure corresponding to the “means” indicates that the claim fails to pass muster under 35 U.S.C. § 112, second paragraph. *See In re Dossel*, 115 F.3d 942, 944-46 (Fed. Cir. 1997).

² “For each independent claim involved in the appeal and for each dependent claim argued separately under the provisions of paragraph (c)(1)(vii) of this section, every means plus function and step plus function as permitted by 35 U.S.C. 112, sixth paragraph, must be identified and the structure, material, or acts described in the specification as corresponding to each claimed function must be set forth with reference to the specification by page and line number, and to the drawing, if any, by reference characters.”

CONCLUSION

The rejection of claims 5-11 under 35 U.S.C. § 102(e) as being anticipated by Schneider is reversed.

In new grounds of rejection, we reject claims 5-11 under 35 U.S.C. § 101 as being directed to non-statutory subject matter and claim 11 under 35 U.S.C. § 112, second paragraph, as being indefinite.

With respect to the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides that “Appellant may file a single request for rehearing within two months from the date of the original decision of the Board.”

In addition to affirming the Examiner’s rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellants elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellants elect prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

REVERSED -- 37 C.F.R. § 41.50(b)

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